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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,490	09/12/2000	Tadahiro Aihara	04329.2392	6306

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EXAMINER	
FLANDERS, ANDREW C	

ART UNIT	PAPER NUMBER
2644	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/660,490	AIHARA ET AL.	
	Examiner	Art Unit	
	Andrew C. Flanders	2644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9-23 and 25-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9-13, 16-23, 25-29 and 32-34* is/are rejected.

7)☒ Claim(s) *14,15,30 and 31* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 September 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

First, Applicant has amended claims 1, 17 and 33 which renders the arguments moot as the scope of the claims have changed. Even if Applicants were persuasive, they are moot due to the amendment. Applicant alleges in the arguments regarding claims 1 – 4, 17 – 20, and 33 – 34 that Murray fails to explicitly disclose means for requesting content from an external device and supports this allegation by pointing out that the messages are retrieved from object store memory 6016.

Examiner respectfully disagrees with this allegation. Applicant fails to acknowledge that the Murray discloses that the phone server stores the voice and other audio messages separate from the users pc; col. 4 lines 16 – 22; as a result, as the user must request them from the external storage device.

Applicant further alleges that the inherency of the communication from the external system to the device does not teach or suggest "wherein said setting means comprises means for receiving a mode setting command from the external device".

Examiner respectfully disagrees with this allegation. Examiner is unsure of the reasoning used by Applicant. It is unclear to the Examiner what reasoning is used to show that the inherency is insufficient to meet the limitations. It appears as though the Applicant is only making a statement that the reasoning in the action does not meet the

claims, however no reasoning or evidence appears to be provided Merely alleging that the inherency does not teach the mode setting means does not provide sufficient evidence to prove it. Further, the mere fact that the system communicates to the external device does indeed set modes. One mode being the mode in which the device is connected to the external system for the transfer of information.'

Applicant further alleges that the teachings taught by Maehishi in the combination in the previous rejection of claims 9 – 13, 16, 25 – 29 and 32 do not teach, "a recording command" or "means for enabling said recording means when said detecting means detects that the sufficient amount of the content data is buffered" Again, Examiner is unsure of the reasoning used by Applicant. It is unclear to the Examiner what reasoning is used to show that the limitations are not shown. It appears as though Applicant, through the statement "The passages cited by the Examiner, teach limiting the writing of the data stream to ensure that the second buffer will not underflow" is alleging the limitations in question are not met. However, that statement alone provides sufficient reasoning to apply the art to the limitations in question. To be more specific, the writing is selectively restricted if there is not sufficient content buffered, if there is sufficient content buffered, the temporary restriction is lifted, thus showing means for enabling said recording means when said detecting means detects that a sufficient amount of content is buffered. Further, as shown in the previous rejection, there is a write inhibit flag which is selectively set dependent upon the condition of the read out buffer (i.e. detecting means detects that the sufficient amount of the content data is buffered), this

flag is set when the threshold falls below a certain value and lifted when the value is sufficient (i.e. means for enabling said recording means). Furthermore, the limitation of the recording command is present in the combination contrary to Applicants' allegation. The transfer of files to the Burrows device via the method disclosed by the Maehishi method requires a start and stop. The system will not just send data. Further, while not anticipated by Burrows, the reference does disclose using the computer to send data; col. 5 lines 1 – 5. In combination with the Maehishi reference, this makes obvious the limitation of the recording command.

Claim Rejections - 35 USC § 102

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5 – 7 and 21 – 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Moon (U.S. Patent 6,629,000).

Regarding **Claims 5 and 21**, Moon discloses a transmitter/receiver that receives data from a PC (Fig. 2 element 800) (i.e. means for recording a content supplied from an external device), headphones and speakers (Fig. 2 element 705) (i.e. means for

reproducing the content), determining if there is a connection with the external device (Fig. 3a element 1800) (i.e. means for determining whether or not the apparatus is connected to the external device), an information selector portion (fig. 2 element 300) (i.e. means for selectively setting an operation mode) and the information selector contains predetermined keys operated by the user, and outputs electrical signals according to the user selections to control the supply of power, extract data for reproduction, control various functions related to the reproducing of data and transmit and receive data (col. 3 lines 59 – 65) (i.e. means for controlling said recording means and said reproducing means in accordance with the operation mode set by said setting means when said determine means determines that the apparatus is connected to the external device).

Further more, Moon discloses determining whether the device is connected to an external system (Fig. 3a element 1800). In order to determine whether the system is connected it is inherent there must be some sort of communication from the external system to the device whether it be a signal or an impendence detection it is supplied by the external system (i.e. wherein said setting means comprises means for receiving a mode setting command from the external device).

Regarding **Claims 6 and 22**, in addition to the elements stated above regarding claims 5 and 21, Moon discloses connecting to an external device and not communicating with that device until sound data is not being reproduced (Fig. 3a elements 1700 and 1800, Fig 3b element 1420, Fig 3e, and Fig 3f) (i.e. wherein said

setting means sets one of a first mode, a second mode, a third mode, and a fourth mode; and the first mode is set, reproduction is continued if the apparatus is connected to the external apparatus during reproduction).

Regarding **Claims 7 and 23**, in addition to the elements stated above regarding claims 5 and 21, Moon discloses a reproduction signal (Fig. 3b element 1420) (i.e. wherein said setting means comprises an interface device for manually setting the operation mode).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 – 4, 17 – 20, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galensky (U.S. Patent 6,845,398) in view of Murray (U.S. Patent 5,699,089)

Regarding **Claims 1 and 17**, Galensky discloses:

A recording and reproducing apparatus (Fig. 2) comprising:

means for requesting content from an external device (i.e. the user accesses the server and selects one or more desired multimedia files that are streamed to the wireless device; col. 3 lines 50 – 63);

means for recording the content supplied from the external device (i.e. the multimedia files are stored; col. 4 lines 15 – 27);

means for stopping the recording of the content supplied form the external device (i.e. the file is transferred until all of the data is transmitted and the multimedia file has ended); and

means for reproducing the content (i.e. the multimedia files are played by the wireless device; col. 3 lines 50 – 63).

Galensky does not explicitly disclose that the means for stopping the recording of the content supplied from the external device is done after receiving an end-of-content notification from the external device. However, it is well known that MP3 files (the type of files being transferred) contain a trailer which is known as an ID3v1 tag. Since this tag is located at the end of the MP3, it effectively signals the end of the file. Thus, if Galensky's system stops at the end of the file after the file has been transmitted, recording will be stopped after the ID3v1 tag is transmitted an thus read upon the limitation of stopping the recording of the content supplied from the external device after receiving an end-of-content notification from the external device.

Furthermore, Galensky fails to explicitly disclose means for determining whether or not said reproducing means performs a reproduction when a recording command is

issued or means for disabling said reproducing means and enabling said recording means when said determining means determines that said reproducing means performs the reproduction when the recording command is issued.

Murray discloses a playback mode for playing sequential objects (audio in the instant case) in which the system determines whether or not the system is playing when the recording button is pressed. If playing is occurring, the presses play stop step is initiated and then the playback is halted; Fig. 6G. Applying this to the combination would read upon the limitations of means for determining whether or not said reproducing means performs a reproduction when a recording command is issued or means for disabling said reproducing means and enabling said recording means when said determining means determines that said reproducing means performs the reproduction when the recording command is issued.

IT would have been obvious to one of ordinary skill in the art at the time of the invention to apply Murray's playback mode to the combination. One would have been motivated to do so to control multiple sequential playback objects (i.e. the audio files) which provides for the ease of use, reduction of screen clutter, rapidity of command execution and conservation of computer resources; col. 2 lines 38 – 44 in Murray.

Regarding **Claims 2 and 18**, in addition to the elements stated above regarding claims 1 and 17, the combination further discloses:

means for enabling said recording means when said determining means determines that said reproducing means does not perform reproduction (i.e. Murray

further discloses if the system is not currently playing to advance to the recording step (Fig. 6G element 6148 and 6150)

Regarding **Claim 3 and 19**, in addition to the elements stated above regarding claims 1 and 17, the combination further discloses:

second determining means for determining whether or not said recording means is turned on when the recording command is issued (i.e. Murray further discloses determining whether the system is currently recording when the record button is pressed (Fig. 6G element 6140); and

means for turning on said recording means when said second determining means determines that recording means is not turned on (i.e. and if not, the system eventually advances to step 6150 where the system begins recording (Fig. 6G)

Regarding **Claim 4 and 20**, in addition to the elements stated above regarding claims 1 and 17, the combination further discloses:

means for restarting interrupted reproduction after recording is completed (i.e. Murray further discloses when the record button is pressed they system completes the request and then waits for the next event (Fig. 6B elements 6042, 6056 and 6030) and a play button for playing back data as the next event (Fig. 6B element 6040).

Regarding **Claim 33**, claim 1 makes obvious all limitations of claim 33 except for means for determining whether or not the apparatus is connected to the external device.

In the combination, substituting the connection disclosed by Galensky for the telephone connection disclosed by Murray reads upon this limitation.

Regarding **Claim 34**, in addition to the elements stated above regarding claim 33, the combination further discloses:

means for enabling the reproducing mode to restart reproduction after the recording of the new content is complete (i.e. Murray further discloses when the record button is pressed they system completes the request and then waits for the next event (Fig. 6B elements 6042, 6056 and 6030) and a play button for playing back data as the next event (Fig. 6B element 6040)

Claims 9 – 13, 16 and 25 – 29, 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Burrows (U.S. Patent 6,377,530) in view of Maehashi (U.S. Patent 6,587,641).

Regarding **Claims 9 and 25**, Burrows discloses

means for recording a content supplied from an external device (i.e. a computer jack; Fig. 1 element 132)

means for reproducing the content the reproducing means buffering content data before reproduction (i.e. a compressed audio data buffer and an audio output jack; Fig. 1 elements 108 and 130).

Burrows does not explicitly disclose means for detecting that a sufficient amount of the content data is buffered when a recording command is issued during reproduction; and

means for enabling said recording means when said detecting means detects that the sufficient amount of the content data is buffered.

Maehashi discloses

Writing limiting means constantly monitors the second predicted consumption duration worked out by second consumption duration predicting means, when the second predicted consumption is less than the second threshold value, a write inhibit flag is erected to bar writing means from writing; col. 7 lines 32 – 38; and in the case the second predicted consumption duration is larger than the second threshold value, the write inhibit flag is lifted to lift the ban on writing; col. 7 lines 48 – 51.

Applying this disc access teaching to the Burrows reference would allow Burrows to record during playback when a recording command was issued (i.e. connecting the device to the computer via the computer jack; Fig. 1). The combination would read upon the limitation of means for detecting that a sufficient amount of the content data is buffered when a recording command is issued during reproduction; and

means for enabling said recording means when said detecting means detects that the sufficient amount of the content data is buffered.

It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Maehashi's disk recording and reproducing technique to the player

disclosed by Burrows. One would have been motivated to do so to prevent interruption during reading or writing; See Maehashi col. 1 lines 5 – 60.

Regarding **Claims 10 and 26**, in addition to the elements stated above regarding claims 9 and 25, the combination of Burrows in view of Maehashi further discloses:

means for disabling said recording means when said detecting means does not detect that the sufficient amount of the content data is not buffered (i.e. when the second predicted consumption is less than the second threshold value, a write inhibit flag is erected to bar writing means from writing; col. 7 lines 32 – 38 in Maehashi).

Regarding **Claim 11 and 27**, in addition to the elements stated above regarding claims 10 and 26, the combination of Burrows in view of Maehashi further discloses:

means for keeping reproduction of said reproducing means when said detecting means detects that the sufficient amount of the content data is buffered (i.e. video-audio data being read is kept real-time by temporarily restricting the writing of video-audio data in the storage device on the basis of the second predicted consumption duration while the data is being read; col. 8 lines 1 – 5; and in the case the second predicted consumption duration is larger than the second threshold value, the write inhibit flag is lifted to lift the ban on writing; col. 7 lines 48 – 51 in Maehashi).

Regarding **Claims 12 and 28**, in addition to the elements stated above regarding claims 10 and 26, the combination of Burrows in view of Maehashi further discloses:

means for starting said recording means when said detecting means detects that the sufficient amount of the content data is buffered (i.e. and in the case the second predicted consumption duration is larger than the second threshold value, the write inhibit flag is lifted to lift the ban on writing; col. 7 lines 48 – 51 in Maehashi).

Regarding **Claims 13 and 29**, in addition to the elements stated above regarding claims 9 and 25, the combination of Burrows in view of Maehashi further discloses:

means for setting an operation mode (i.e. burrows discloses a user interface with various settings; Fig. 1 element 116);

and means for controlling said reproducing means in accordance with the operation mode when said detecting means detects that the sufficient amount of the content data is not buffered (i.e. when the play command is issued in Burrows, Maehashi discloses that video-audio data being read is kept real-time by temporarily restricting the writing of video-audio data in the storage device on the basis of the second predicted consumption duration while the data is being read; col. 8 lines 1 – 5).

The combination does not explicitly disclose means for controlling said recording means in accordance with the operation mode when said detecting means detects that the sufficient amount of the content data is not buffered. However, it is inherent that there must be some means present to allow for a recording. A recording operation must be set in order to start the method disclosed by Maehashi. Thus, in addition to the cited passages stated above, this reads upon the claimed limitation of means for controlling

said recording means in accordance with the operation mode when said detecting means detects that the sufficient amount of the content data is not buffered.

Regarding **Claims 16 and 32**, in addition to the elements stated above regarding claims 13 and 29 the combination of Burrows in view of Maehashi further discloses:

wherein said setting means comprises means fro receiving a mode setting command from the external device (in addition to the user interface, the host computer when coupled to the system can perform various operations; col. 5 lines 1 – 5)

Allowable Subject Matter

Claims 14, 15, 30 and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

Claims 14 and 30 teach various modes of operation when a recording and reproducing apparatus is connected to an external device. The closest prior art in the reproduction and recording art [see Moon (U.S. Patent 6,629,000); Burrows (U.S.

Patent 6,377,530); Dwyer (U.S. Patent 6,671,567); Pawlowski (U.S. Patent 6,038,199); all of these reference teach connecting a recording/reproducing device to an external device for the purpose of transferring data] teaches of connecting various devices to external devices to transfer data. However, the prior art does not teach the level of detail as disclosed in applicant's dependent claims 14 and 30 nor would it have been obvious to one of ordinary skill in the art at the time of the invention to modify these reference's to operate as applicant's claims 14 and 30 teach.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C. Flanders whose telephone number is (571) 272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on (571) 272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

acf

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PRIMARY EXAMINER